



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/766,961

01/30/2004

Takako Takei

402958/SOGA

2499

23548 7590 07/09/2007

LEYDIG VOIT & MAYER, LTD

700 THIRTEENTH ST. NW

SUITE 300

WASHINGTON, DC 20005-3960

EXAMINER

KOSLOW, CAROL M

ART UNIT

PAPER NUMBER

1755

MAIL DATE

DELIVERY MODE

07/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/766,961	Applicant(s) TAKEI ET AL.	
	Examiner C. Melissa Koslow	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration:
- 5) ☒ Claim(s) 1,4,5,7,17 and 18 is/are allowed.
- 6) ☒ Claim(s) 2,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 6 and 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1755

This action is in response to applicants' amendment of 4 June 2007. The objection to the disclosure with respect to ".m" is withdrawn since the amendment of 14 June 2004 corrected this informality. The amendment to the disclosure has overcome the new matter objection. The amendments to the claims have overcome the 35 USC 112 rejections, the art rejections over claims 1, 2, 5, 7 and 11-16 and the art rejection of claim 9 over U.S. patent 5,211,896. Applicant's arguments with respect to the remaining objection to the disclosure and the art rejections of claims 9 and 10 have been fully considered but they are not persuasive.

The disclosure is objected to because of the following informalities: The wording with respect to the comparative examples on pages 10 and 16 teaches the magnet powder were coated with both the coupling agent and resin powder, which is the inventive precursor. Thus it is unclear how these comparative examples differ from the claimed invention. Appropriate correction is required.

Applicants' amendment and discussion did not overcome this objection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by U.S. patent 5,211,896.

This reference teaches producing a plastic magnetic by injection molding thermoplastic resin coated magnetic iron particles. This plastic magnet teaches that claimed. The fact the coating is a uniform coating, not a powder coating, does not appear to produce a different final product from that claimed since the injection molding process will melt and/or soften the powder so that it forms a continuous coating around the

Art Unit: 1755

magnetic particles in the magnet. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.

The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

*In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The reference teaches the claimed magnet.

The amendment to claim 2 does not overcome the rejection since there is no showing that the magnet resulting from injection molding the precursor of claim 2 will produce a different magnet than that taught in the reference. The rejection is maintained.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 5,429,899.

This reference teaches a plastic magnet produced by injection molding pellets of a mixture of a thermoplastic resin and a magnetic powder coated with a coupling agent, where the pellets are produced by kneading, for example in both a press kneader and a calendar roll. The resulting magnet and that claim appear to be identical or so similar so as not to be obvious over each other. The claims are product-by-process claims. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d

Art Unit: 1755

695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The reference teaches the claimed magnet.

The comparative examples in applicants' specification are produced by a different method than that of the reference and thus do not show that the taught plastic magnet is different and obvious over the claimed magnets.

The amendments to claims 1 and 2 does not overcome the rejection since there is no showing that the magnet resulting from injection molding the precursor of claims 1 and 2 will produce a different magnet than that taught in the reference. The rejection is maintained.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 5,200,270.

This reference teaches a plastic magnet composition comprising a thermoplastic resin having adhered thereto magnetic particles, where the magnetic particles are adhered to the resin by melting the surface of the resin particles (col. 1, lines 47-54 and col. 2, lines 10-18 and col. 3, lines 14-32). The reference teaches the claimed material.

Claims 1, 4, 5, 7, 17 and 18 are allowable over the cited art of record for the reasons given in the previous action.

Claims 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

There is no teaching or suggestion in the cited art of record to add a metal deactivator or an antioxidant for the thermoplastic to the composition taught in U.S. patent 5,200,270.

Art Unit: 1755

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk  
July 5, 2007

  
C. Melissa Koslow  
Primary Examiner  
*Tech. Center 1755*